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EXAMINER
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THERIAULT, STEVEN B

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2179

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/06/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/805,668	Applicant(s) BURKE ET AL.	
	Examiner Steven B. Theriault	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is responsive to the following communications: Amendment filed 01/12/2007.
2. Claims 1- 65 are pending in the case. Claims 1, 32- 34, 45, 56-58, and 61-62 are the independent claims.

#### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 34-44 and 65 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claims raise a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

With regard to **claims 34-44**, claims 34-44 and 65 recite claim limitations that are not directed to a statutory class of invention as the claimed system refers to software components in a system. The computer readable computer code is not a process, machine, article of manufacture or composition of matter and it is software per-se. There is currently no class of invention named software in the MPEP. A possible suggestion is for the claim to recite a computer readable storage media comprising... which would put the claim into the article of manufacture class of invention. The specification includes verbiage that comprises a transmission media and it is important to distinguish the type of media on which the instructions are stored. Transmission media is not currently a statutory medium for which an apparatus can be tangibly embodied.

#### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-18, 20-65 are rejected under 35 U.S.C 102(e) as being anticipated by Cadiz et al (hereinafter Cadiz) U.S. Pub. No. 20020186257 published Dec. 12, 2002 and filed June 8, 2001.**

In regard to **Independent claim 1**, Cadiz teaches a method of providing a modified context menu in place of an existing context menu in existing software, the method comprising:

- Providing a client-side software module for modifying an existing context menu, the client-side software module comprising additional menu information, the client-side software module being configured for: (Cadiz page 20, Para 0192 and Figure 5) Cadiz teaches a ticket wizard (module) that reside in the client that allows a user to modify a context sensitive menu. The sidebar container menu is provided on the display as shown in figures 6-11.
- Detecting an event that requires display of a context menu (Cadiz Para 0193) Cadiz teaches the detection of an event to display an additional context menu to modify the sidebar components.
- Modifying the existing context menu based on the additional menu information (Cadiz Para 0192-0194). Cadiz teaches the ticket xml files describes the new menu to be added and the container displays the information based on the menus properties.
- Displaying the modified context menu;
  - Wherein the modified context menu is different than the existing context menu, the modified context menu comprising an additional menu item as part of the context menu, the additional menu item being positioned within the modified context menu in accordance with the additional menu information and not in accordance with the existing software (Cadiz Para 0080-0084 and 0091-0093 and figures 5-11b)

With respect to **dependent claim 2**, Cadiz teaches the method the existing context menu

comprising at least one existing menu item, the additional menu item being positioned above the existing menu item in the modified context menu (Cadiz Para 0107-0111 and 0179-0180).

With respect to **dependent claim 3**, Cadiz teaches the method wherein the modified context menu comprises an icon displayed with the additional menu item (Cadiz figures 11a-11b and Para 0176 and 0179-0180 and 0204).

With respect to **dependent claim 4**, Cadiz teaches the method wherein the additional menu information comprises information related to an icon to be associated with the additional menu item (Cadiz figures 11a-11b and Para 0176 and 0179-0180 and 0204).

With respect to **dependent claim 5**, Cadiz teaches the method wherein the additional menu item comprises at least one sub menu that comprises at least one additional sub menu item) Cadiz figure 7 and Para 0108 and 0200)

With respect to **dependent claim 6**, Cadiz teaches the method wherein the client-side software module is provided to a user computer, the user computer displaying a Web page, the Web page being divided into regions, the method further comprising determining in what region the user is interacting with the Web page when the event occurs (Cadiz Para 0096-0097 and 0176-0181 and 0196-0207)

With respect to **dependent claim 7**, Cadiz teaches the method further comprising selecting for display the additional menu item from a plurality of potential menu items based on the determined region (Cadiz figure 5 and 0192-0207)

With respect to **dependent claim 8**, Cadiz teaches the method wherein the client-side software

module is provided to a user computer, the user computer displaying a user interface, the method further comprising determining a location of the user interface at which the user is interacting with the user interface when the event occurs (Para 0193)

With respect to **dependent claim 9**, Cadiz teaches the method further comprising selecting for display the additional menu item from a plurality of potential menu items based on the determined region (Cadiz Para 0196-0207).

With respect to **dependent claim 10**, Cadiz teaches the method wherein the client-side software module is provided to a user computer, the user computer displaying a user interface, the user interface comprising a plurality of elements, the method further comprising determining which element of the plurality of elements the user is interacting with when the event occurs (Cadiz Para 0176-0194).

With respect to **dependent claim 11**, Cadiz teaches the method further comprising selecting for display the additional menu item from a plurality of potential menu items based on the determined element (Para 0176-0194 and figure 5).

With respect to **dependent claim 12**, Cadiz teaches the method further comprising selecting for display the additional menu item from a plurality of potential menu items based on the location of a user computer to which the client-side software module is provided (Para 0114)

With respect to **dependent claim 13**, Cadiz teaches the method wherein the client-side software module is provided to a user computer, the user computer displaying a Web page, the Web page comprising a plurality of elements, the method further comprising determining which element of the plurality of elements the user is interacting with when the event occurs (Cadiz Para 0096-0097 and 0176-0181 and 0196-0207)

With respect to **dependent claim 14**, Cadiz teaches the method further comprising selecting for display the additional menu item from a plurality of potential menu items based on the determined element(Para 0176-0194 and figure 5).

With respect to **dependent claim 15**, Cadiz teaches the method wherein determining which element the user is interacting with comprises: identifying an element from the plurality of elements that comprise an HTML structure; determining a type of the element; saving information related to the element; determining when the user has selected text; and saving the selected text (Cadiz Para 0116 and 0185-0195 and figure 8b –8c).

With respect to **dependent claim 16**, Cadiz teaches the method wherein identifying an element from the plurality of elements that make up the HTML structure, determining the type of the element, and saving information related to the element are repeated for elements above a first identified element in the HTML structure until an element above the first identified element is no longer valid (Cadiz Para 0211- 0212).

With respect to **dependent claim 17**, Cadiz teaches the method wherein the additional menu item is configured based on the saved information related to the element and the saved text (Cadiz Para 0091- 0093).

With respect to **dependent claim 18**, Cadiz teaches the method further comprising, prior to modifying the existing context menu, obtaining information related to the existing context menu (Cadiz Para 0091- 0093).

With respect to **dependent claim 20**, Cadiz teaches the method wherein the client-side software

module comprises a control that operates with the browser (Cadiz Para 0095-0097).

With respect to **dependent claim 21**, Cadiz teaches the method wherein the control is implemented using an ActiveX control (Cadiz Para 0096-0097).

With respect to **dependent claim 22**, Cadiz teaches the method further comprising providing the additional menu item as part of a general feed including button characteristics of a plurality of buttons for a downloadable toolbar, wherein the downloadable toolbar receives the additional menu item as a button that is not displayed (Cadiz Para 0211-0212 and Figures 5-13).

With respect to **dependent claim 23**, Cadiz teaches the method wherein the providing of the additional menu item is performed by a server (Cadiz Para 0055-0057 and Para 0083).

With respect to **dependent claim 24**, Cadiz teaches the method the modifying the existing context menu comprising adding the additional menu item to the existing context menu using an application-programming interface (Para 0116-0117).

With respect to **dependent claim 25**, Cadiz teaches the method wherein an Internet content provider maintains for a user a user account comprising user account information, and the modified context menu is configured based on the user account information (Cadiz Para 0165).

With respect to **dependent claim 26**, Cadiz teaches the method further comprising selecting for display the additional menu item from a plurality of potential menu items based on the user account information (Cadiz Para 0114 and 0165).

With respect to **dependent claim 27**, Cadiz teaches the method further comprising providing the user with the ability to log in to the content provider (Cadiz Para 0114 and 0165).



With respect to **dependent claim 28**, Cadiz teaches the method wherein the selecting for display the additional menu item is determined by the content provider based upon the user account information such that the selection of the additional menu item is personalized in accordance with preferences of the user (Cadiz Para 0114 and 0165).

With respect to **dependent claim 29**, Cadiz teaches the method wherein the user account information is maintained by the content provider, independent of a first computer having a first browser that the user utilizes, such that the selection of the additional menu item remains personalized when the user utilizes a second computer having a second browser (Cadiz Para 0114 and 0165).

With respect to **dependent claim 30**, Cadiz teaches the method wherein the personalization of the selection of the additional menu item is based upon the location of the first computer, when the user utilizes the first computer, and is based upon the location of the second computer, when the user utilizes the second computer, such that the selection of the additional menu item is modified based upon a location of a computer utilized by the user (Para 0112-0116).

With respect to **dependent claim 31**, Cadiz teaches the method wherein the modified context menu is configured based on a detected location at which the user is utilizing the existing software (Cadiz Figures 5-13) Cadiz shows the user can add a sidebar item to the display and arrange the items to their desire.

In regard to **Independent claim 32**, Cadiz teaches a method of providing a modified context menu in place of an existing context menu in existing software, the method comprising controlling an Internet browser user interface displayable by an Internet browser on a display of a computer, and enabling a user of the computer and Internet browser to access and navigate the Internet

and to receive and display one or more Web pages from one or more Internet sites, including the display of a Web page from a predetermined Internet site, the Internet browser having at least one Internet browser toolbar having at least one toolbar button providing predetermined functionality to the user of the computer and Internet browser (See figures 5-13 and Para 0096-0097), the method comprising:

- o Providing, at the predetermined Internet site, access to a client-side software module for controlling the Internet browser interface (Para 0112-0018) and making available for downloading by the predetermined Internet site the client-side software module for causing the display of a user toolbar that, by virtue of its being downloaded, makes additional functionality that is not part of the Internet browser prior to download available to the user after download (Para 0112-0018), such that once the user toolbar is displayed the user toolbar remains displayed and the additional functionality remains available to the user regardless of a subsequent Internet site to which the Internet browser is caused to navigate after download (Para 0091-0097); the client-side software module being configured for: detecting an event that requires display of a context menu; modifying the existing context menu based on additional menu information; and displaying the modified context menu; wherein the modified context menu is different than the existing context menu, the modified context menu comprising an additional menu item as part of the context menu, the additional menu item being positioned within the modified context menu in accordance with the additional menu information and not in accordance with the existing software (Para 0176-0194) Cadiz teaches a toolbar that is web-based that provides a variety of context based menus. The user can drag a drop a new ticket, that comprises a menu item to be added to the toolbar, onto the sidebar and add a service that was not on the toolbar previously and will be stored in the user's profile. The user can also add sub-menu items where the information in the ticket comprises instructions on how the information in the menu is to be displayed.

In regard to **Independent claim 33**, Cadiz teaches a method of controlling an Internet browser interface displayable by an Internet browser on a display of a computer, and enabling a user of the computer and Internet browser to access and navigate the Internet and to receive and display on the computer display one or more Web pages from one or more Internet sites (Para 0091-0097), comprising:

- Providing, at a predetermined Internet site, access to a program for controlling the Internet browser interface and making available for downloading by the predetermined Internet site, a file for causing the display of a persistent user toolbar, the user toolbar making additional functionality that is not part of the Internet browser prior to download available to the user after download as part of the Internet browser interface, the additional functionality (Para 0176-0194) *Cadiz teaches the toolbar tickets/viewers are downloadable to a device and are part of a browser based application comprising:*
  - Detecting an event that requires display of a context menu; modifying the existing context menu based on additional menu information; and displaying the modified context menu; wherein the modified context menu is different than the existing context menu, the modified context menu comprising an additional menu item as part of the context menu, the additional menu item being positioned within the modified context menu in accordance with the additional menu information and not in accordance with the existing software (Para 0176-0194 and figures 5-13). Cadiz teaches the user can drag a drop a new ticket, that comprises a menu item to be added to the toolbar, onto the sidebar and add a service that was not on the toolbar previously and will be stored in the user's profile. The user can also add sub-menu items where the information in the ticket comprises instructions on how the information in the menu is to be displayed. When a user adds a new e-mail contact or adds a

new service, Cadiz teaches the interface adds a ticket that modifies the overall menu toolbar displayed to the user in the area that the user chooses to enter the new service.

In regard to **claims 34-44, 65**, claims 34-44, 65 reflect the computer readable code comprising computer readable instructions for performing the methods steps of claims 1-9 and 15-16, respectively, and therefore are rejected along the same rationale. With respect to claim 65, Cadiz teaches the toolbar of the application is downloadable as the ticket/viewer and container combinations can exist on a network and can be pushed to the client machine (See Para 0084, 0098-0099)

In regard to **claims 45-55**, claims 45-55 reflect the computer readable code comprising computer readable instructions for performing the methods steps of claims 1-9 and 15-16, respectively, and therefore are rejected along the same rationale.

In regard to **Independent claim 56**, Cadiz teaches a method of providing a modified context menu in place of an existing context menu in existing software, the method comprising:

- Providing, to a user computer displaying a Web page comprising a plurality of elements, a client-side software module for modifying an existing context menu, the existing context menu comprising at least one existing menu item, the client-side software module comprising additional menu information, the client-side software module being configured for: detecting an event that requires a context menu (Para 0112-0018) Cadiz teaches a browser based toolbar that contains a plurality of items that are menu items. Cadiz teaches the user can add a menu item on the toolbar in the location that they choose.

- Modifying the existing context menu based on the additional menu information (Cadiz Para 0077-0082 and 0112-0115) Cadiz teaches the user adds a new ticket to an existing context based menu bar.
- Displaying the modified context menu, wherein the modified context menu is different than the existing context menu, the modified context menu comprising an additional menu item as part of the context menu, the additional menu item being positioned relative to the existing menu item within the modified context menu in accordance with the additional menu information and not in accordance with the existing software, and wherein the modified context menu comprises an icon displayed with the additional menu item (Para 0176-0194 and figures 5-13) Cadiz shows the new toolbar displayed on the interface with the new ticket added that the user chose to add and where the information in the XML data file of the ticket describes how the information is to be presented.
- Identifying an element from the plurality of elements that comprise an HTML structure; determining a type of the element; saving information related to the element; determining when the user has selected text (Cadiz Para 0077-0078)
- Saving the selected text; wherein identifying an element from the plurality of elements that make up the HTML structure, determining the type of the element, and saving information related to the element are repeated for elements above a first identified element in the HTML structure until an element above the first identified element is no longer valid and wherein the additional menu item is configured based on the saved information related to the element and the saved text (Cadiz Para 0077-0082) Cadiz teaches the DHTML tickets that are saved on a database to be accessed by the ticket manager to be presented to the user interface. Cadiz teaches the ticket information can be dynamic and updateable within the ticket (See Para 0164-0169) and where tickets can automatically be added to the toolbar based on the user's

selections.

In regard to **Independent claim 57**, Cadiz teaches a method of providing to a user, by an Internet content provider, a modified context menu in place of an existing context menu in existing software, the method comprising:

- Providing the user with the ability to log in to the content provider (Para 0165)
- Maintaining for the user a user account comprising user account information, providing a client-side software module for modifying an existing context menu, the client-side software module comprising additional menu information and being configured for: detecting an event that requires display of a context menu (See Para 0164-0169) Cadiz teaches the user profile roams to the specific device and based on the profile the device the appropriate ticket/viewer will be presented.
- Selecting for display the additional menu item from a plurality of potential menu items based on the user account information such that the selection is personalized in accordance with preferences of the user;
- Displaying the modified context menu; wherein the modified context menu is different than the existing context menu, the modified context menu comprising an additional menu item as part of the context menu, the additional menu item being positioned within the modified context menu in accordance with the additional menu information and not in accordance with existing software; and wherein the user account information is maintained by the content provider, independent of a first computer having a first browser that the user utilizes, such that the selection of the additional menu item remains personalized should the user utilize a second computer having a second browser(Para 0176-0194 and figures 5-13) Cadiz shows the new toolbar displayed on the interface with the new ticket added that the user chose to add and where the information in the XML data file of the ticket describes how the information

is to be presented. Cadiz also teaches that the system (0112-0115) will provide tickets to a PDA that are not provided on a users desktop or visa-versa where the tickets provide device specific utility and as such the system of Cadiz is a browser based system that can run on a PDA or desktop or both, which is a first and second browser arrangement.

In regard to **Independent claim 58**, Cadiz teaches a method of providing a modified context menu in place of an existing context menu in existing software, the method comprising: accessing additional menu information; detecting an event that requires display of a context menu; modifying the existing context menu based on the additional menu information; and displaying the modified context menu; wherein the modified context menu is different than the existing context menu, the modified context menu comprising an additional menu item as part of the context menu, the additional menu item being positioned within the modified context menu in accordance with the additional menu information and not in accordance with the existing software(Para 0012-0015 and 0164-0169). Cadiz teaches a mechanism to add a context menu to a sidebar to be included within an existing set of context menus (See 0104-0111). The new menu can be any type of information that the user desires to monitor (See 0192-0195) and once the user chooses to add the ticket and drags and drops the ticket on the toolbar the ticket is added and the information related to the ticket is retrieved. The ticket describes how the information is to be displayed and not the container in which the ticket is added.

With respect to **dependent claim 59**, Cadiz teaches a method the existing context menu comprising at least one existing menu item, the additional menu item being positioned above the existing menu item in the modified context menu (Cadiz Para 0107-0111 and 0179-0180).

With respect to **dependent claim 60**, Cadiz teaches a method wherein the modified context menu comprises an icon displayed with the additional menu item (Cadiz figures 11a-11b and Para 0176 and 0179-0180 and 0204).

In regard to **Independent claim 61**, Cadiz teaches a method of providing an additional menu item for inclusion in a context menu of one or more existing menu items, the method comprising: providing information regarding position of the additional menu item within the context menu, the additional menu item not being an existing menu item; and making the additional menu item available to be displayed to a user as part of the context menu in accordance with the information regarding position (Para 0176-0181) Cadiz teaches the tickets can be displayed, arranged and dropped in any configuration the user desires. Further, Cadiz teaches the location within the toolbar can be locked or fixed, which is a position indicator.

In regard to **Independent claim 62**, Cadiz teaches a method of providing an additional menu item for inclusion in a context menu of one or more existing menu items, the method comprising: providing additional menu information regarding the additional menu item, the additional menu item not being an existing menu item; receiving context menu information related to the existing menu items; modifying the context menu information based on the additional menu information; and making the additional menu item available to be displayed to a user as part of the context menu (Para 0012-0015 and 0164-0169). Cadiz teaches a mechanism to add a context menu to a sidebar to be included within an existing set of context menus (See 0104-0111). The new menu can be any type of information that the user desires to monitor (See 0192-0195) and once the user chooses to add the ticket and drags and drops the ticket on the toolbar the ticket is added and the information related to the ticket is retrieved.

With respect to **dependent claim 63** Cadiz teaches a method wherein the additional menu



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information comprises information regarding position of the additional menu item relative to the existing menu items within the existing context menu (Cadiz Para 0107-0111 and 0179-0180).

With respect to **dependent claim 64**, Cadiz teaches a method further comprising:  
determining that a context menu is to be displayed; in response to determining the context menu is to be displayed, accessing context menu information related to the existing context menu (Para 0084-0088).

**It is noted that any citation to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).**

***Claim Rejections - 35 USC § 103***

5. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. **Claims 19 is rejected under 35 U.S.C 102(e) as being anticipated by Cadiz et al (hereinafter Cadiz) U.S. Pub. No. 20020186257 published Dec. 12, 2002 and filed June 8, 2001.**

With respect to **dependent claim 19**, as indicated in the above discussion, Cadiz teaches every element of claim 18.

Cadiz does not expressly teach the method wherein the obtaining comprises subclassing a browser window. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Cadiz, because Cadiz teaches that a derived interface contract is established with the active-x servers in which a tickets viewer can access the tickets XML files via an interface. The ticket interface is a COM interface between the container and the ticket viewer server, which provides an interface to each viewer. A derived interface contract, in the examiners interpretation, is a sub-classed browser mechanism if the interface runs within a browser and intercepts messages to and from the server without interfering with the other components within the toolbar or the display (See 0095-0097 and 0116-0117).

#### ***Response to Arguments***

7. Applicant's arguments filed 01/12/2007 have been fully considered but they are not persuasive.

*Applicant's argument that the Cadiz does not teach modifying the context menu*

Applicant argues that Cadiz does not teach or suggest using modifying a context menu let alone positioning an additional menu item therein because the applicant interprets the prior art of Cadiz as only

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teaching implementing and accessing a context menu as conventional activities and the user does not interact with the context menu they instead interact with the ticket (See argument page 3).

The Examiner disagrees.

The Examiner notes the previous office action (See page 15, bottom) where the Examiner stated that the entire reference cited is relevant for not only what is suggested but for all that would be obvious and relevant to one of ordinary skill in the art. Given that, Cadiz teaches a concept of a ticket. Tickets are graphical objects or dynamic thumbnails that comprise information and a viewer to display the information. Cadiz expressly teaches that each ticket contains context menus to perform operations on the ticket (See Para 71, 133, 180, 193). The claims do not differentiate between an object or a menu for interaction and Cadiz is clear in that context menu are activated with a mouse rollover or cursor event. Therefore, Cadiz teaches context menus. Cadiz then states that each container uses tooltips in conjunction with the context menus to disclose information to the user in the context of the given graphical object (See Para 200). Cadiz teaches that once the user clicks the ticket the system automatically links more detailed information for the selected object and displays the information in a tooltip as a set of commands or as a an HTML web page, which is contextual information (See Para 106 and 186). The Examiner considers a drill down information scheme through a set of nested tooltips as a type of context menu especially when the focus of the information is particularly related to the given object. Moreover, Cadiz teaches a process of the user right clicking on an item that provides a **Menu** and the user can then select commands to edit, delete and **ADD** additional items. Which in combination with the information above, provides support that the structure of Cadiz is capable of: a) providing a client side module to modify a context menu because they can ADD commands to the tooltip or ticket. The tickets of Cadiz are modified by the user and moved by the user at the client. The user can right click on the item to invoke a menu where commands can be added to control a ticket (See Para 187). The system of Cadiz teaches the detecting an event that requires display of a context menu as also shown as the detecting of the right click on an object to bring up a context menu. Cadiz then teaches adding additional commands to the ticket through the context menu commands based on additional information. Cadiz teaches the retrieving of focused information based on the selected item, which is the additional information (See

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Para 0186). Finally, Cadiz teaches the displaying of the menu where the new menu commands were not part of the original software because the commands of Cadiz are specific to the thumbnail of interest. The user is allowed to drag, drop, and create items of interest at will within the interface. Therefore, a new object could be added after the user has opened the interface and the icon was not there originally. Then they can right click on the item and add commands to the item through the interface (See Para 0079-0084 and 0186 – 0187), which would be visible in the context menu invoked when the user either places a cursor over the object or right clicks on it.

*Applicant argues that Cadiz does not provide a teaching of controlling a context menu.*

Applicant argues that Cadiz does not teach or suggest a process of controlling a context menu and does not teach an advancement over the prior art in controlling a context menu (See Page 3, Bottom).

The Examiner disagrees.

In response to applicant's argument that Cadiz does not teach "controlling a context menu", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the prior art of Cadiz teaches a structure that expressly discloses the presenting of a context menu on the client side of a system to a user. The system detects an event to display a context menu and then a process to add a menu item to the context menu. Further, Cadiz provides support that the items of interest associated with the object can be accessed by drilling down on information specific to the object and selecting the associated information, which is a suggestion that not only the information was not provided in the original loading of the software but that the information is in context to the object. A user navigating through a series of nested tooltips performs the same function as drilling down on a given object through a series of menu items. The user can add commands to the given object through a menu and the commands to manage tickets or items displayed in the sidebar (See Para 0187). Therefore, the skilled artisan would determine from the disclosure of Cadiz that the structure is capable of performing the

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limitations of the present application claims because the specific steps of the claims as outlined above are taught or suggested in the teachings of Cadiz.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5598522 to Inatomi which discloses a system that allows for the customization of a context menu on a graphical object.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. Theriault whose telephone number is (571) 272-5867. The examiner can normally be reached on M-F 7:30 - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SBT



**WEILUN LO**  
**SUPERVISORY PATENT EXAMINER**